

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: January 19, 2005 Name: Steven P. ShurtzSignature: /Steven P. Shurtz/

BRINKS
HOFFER
GILSON
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Fred R. Wolf et al.

Appln. No.: 10/687,025

Filed: Sept. 30, 2003

For: CHEWING GUM CONTAINING
PHYSIOLOGICAL COOLING AGENTS

Examiner: Arthur Corbin

Art Unit: 1761

Attorney Docket No: 1391-1554 (COLPCT 03)

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

☒ Second Supplemental Information Disclosure Statement (3 pgs.), PTO 1449 form (2pgs.), copies of fourteen cited references C35-C48; copies of three court documents: 1) Third Amended Answer and Counterclaim, 2) Defendant Cadbury Adams' Responses To Plaintiff Wm. Wrigley Jr., Company's First Set Of Interrogatories, and 3) case docket dated January 6, 2005.

☒ Return Receipt Postcard

Fee calculation:

☒ No additional fee is required.

☐ Small Entity.

☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).

☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).

Fee payment:

☐ A check in the amount of \$_____ is enclosed.

☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.

☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

January 19, 2005

Date

/Steven P. Shurtz/

Steven P. Shurtz - Reg. No. 31,424

BRINKS HOFFER GILSON & LIONE
NBC Tower - Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

BRINKS
HOFFER
GILSON
& LIONE

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: January 19, 2005 Name: Steven P. Shurtz Signature: /Steven P. Shurtz/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Fred R. Wolf et al.

Appln. No.: 10/678,025

Filed: September 30, 2003

For: CHEWING GUM CONTAINING
PHYSIOLOGICAL COOLING
AGENTS

Examiner: Arthur L. Corbin

Art Unit: 1761

Attorney Docket No: 1391/1554 (COLPCT 03)

SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and §§1.97-1.98, and more particularly in accordance with 37 C.F.R. §1.97(b)(4), Applicants hereby cite the following references:

US PATENT DOCUMENTS

DOCUMENT NUMBER <small>Number-Kind Code (If known)</small>	DATE	NAME
2,525,072	10/10/1950	K. K. Kearby et al.
4,020,153	04/26/1977	Rowsell et al.
4,032,661	06/28/1977	Rowsell et al.
4,044,120	08/23/1977	Rowsell et al.
4,059,118	11/22/1977	Watson et al.
4,069,345	01/17/1978	Gascoyne et al.
4,070,496	01/24/1978	Rowsell et al.
4,112,066	09/05/1978	Hussein
4,136,164	01/23/1979	Rowsell et al.
4,137,304	01/30/1979	Rowsell et al.
4,137,305	01/30/1979	Rowsell et al.
4,150,052	04/17/1979	Watson et al.
4,178,459	12/11/1979	Watson et al.
4,193,936	03/18/1980	Watson et al.
4,226,988	10/07/1980	Watson et al.
5,169,658	12/08/1992	Yatka et al.
5,236,719	08/17/1993	Meyers et al.
5,244,760	09/14/1993	Upson et al.
5,458,892	10/17/1995	Yatka et al.
5,543,160	08/06/1996	Song et al.
5,545,416	08/13/1996	Song et al.
5,612,071	03/18/1997	Song et al.

BRINKS
HOFFER
GILSON
& LIONE

Appln. No. 10/678,025

Attorney Docket No.: 1391/1554

DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	NAME
5,614,234	03/25/1997	Song et al.
5,698,181	12/16/1997	Lou
5,800,847	09/01/1998	Song et al.
5,976,581	11/02/1999	Song et al.
6,030,647	02/29/2000	Song et al.
6,080,432	06/27/2000	Tyrpin et al.
6,440,472 B1	08/27/2002	Song et al.
6,455,080 B1	09/24/2002	Wolf et al.
2003/0082271 A1	05/01/2003	Wolf et al.
6,586,023 B1	07/01/2003	Song et al.
6,602,518 B2	08/05/2003	Seielstad et al.
6,613,346 B2	09/02/2003	Seielstad et al.

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY
CA 989738	05/25/1976	Canada
GB 1311060	03/21/1973	United Kingdom
GB 2233873 A	01/23/1991	United Kingdom
WO 93/23005	11/25/1993	WIPO
WO 93/25177	12/23/1993	WIPO
WO 94/08550	04/28/1994	WIPO
WO 94/08551	04/28/1994	WIPO
WO 94/21135	09/29/1994	WIPO
WO 94/25003	11/10/1994	WIPO
WO 94/25009	11/10/1994	WIPO
WO 99/13734	03/25/1999	WIPO
WO 99/13870	03/25/1999	WIPO

OTHER ART REFERENCES

Watson, Hugh R., "Flavor Characteristics of Synthetic Cooling Compounds", <i>Flavor: Its Chemical, Behavioral, and Commercial Aspects Proceedings of the Arthur D. little, Inc. Flavor Symposium, 1997</i> , Published by Westview Press, Boulder CO, 1978, pp 31-50.
Watson, H. R. et al., "New compounds with the menthol cooling effect", <i>J. Soc. Cosmet. Chem.</i> , Vol. 29, 1978, pp. 185-200.

Applicants hereby notify the Patent and Trademark Office of pending litigation involving the parent patent for the present case, U.S. Patent No. 6,627,233, brought by the Assignee of the parent patent and the present patent application, Wm. Wrigley Jr. Company, in the U.S. District Court for the Northern District of Illinois, Civil Docket Case

BRINKS
HOFFER
GILSON
& LIONE

Appln. No. 10/678,025

Attorney Docket No.: 1391/1554

No. 04-CV-346 titled WM. WRIGLEY, JR. COMPANY vs CADBURY ADAMS USA, and submit herewith a copy of the following documents: 1) Third Amended Answer and Counterclaim, 2) Defendant Cadbury Adams' Responses To Plaintiff Wm. Wrigley Jr., Company's First Set Of Interrogatories, and 3) case docket dated January 6, 2005. These documents are provided for consideration by the Examiner in view of the relationship of the issued patent claims and the pending claims, and the allegation of the invalidity of the '233 patent by the defendant.

For the Examiner's convenience, Applicants are enclosing Form PTO-1449 (two pages), and copies of the above listed non-U.S. patent documents. Since all of the listed references are in English, no further commentary is believed to be necessary for those references, 37 C.F.R §1.98(a)(3). With the exception of four documents (US 2003-0082271 A1, which is also a pending application; U.S. 5,698,181; WO 99/13734; and WO 99/13870), the forgoing documents were produced by the defendant in the above litigation, presumably as prior art to the '233 patent. (It is believed that other references produced by the defendant are already of record in this case.) Applicants respectfully request the Examiner's consideration of the above references and entry thereof into the record of this application. Applicants are providing the above three noted court documents so that the Examiner is apprised of the allegations of invalidity. If the Examiner believes that any of the documents listed in the docket report would be of interest to the Examiner, Applicants will provide copies. Further, if the Examiner wishes to be advised of subsequent papers filed in the litigation, he should so indicate.

No fees are believed to be due with this communication. However, if any filing fees are required relating to this submission, the Commissioner is hereby authorized to deduct said fees from Brinks Hofer Gilson & Lione Deposit Account No. 23-1925.

Respectfully submitted,

January 19, 2005
Date

/ Steven P. Shurtz/
Steven P. Shurtz (Reg. No.31,424)

BRINKS
HOFFER
GILSON
& LIONE

-3-

FORM PTO-1449	SERIAL NO. 10/678,025	CASE NO. 1391/1554
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT	FILING DATE Sept. 30, 2003	GROUP ART UNIT 1761
(use several sheets if necessary)		APPLICANT(S): Fred R. Wolf et al.

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	NAME	CLASS/ SUBCLASS	FILING DATE
	C1	2,525,072	10/10/1950	K. K. Kearby et al.		
	C2	4,020,153	04/26/1977	Rowsell et al.		
	C3	4,032,661	06/28/1977	Rowsell et al.		
	C4	4,044,120	08/23/1977	Rowsell et al.		
	C5	4,059,118	11/22/1977	Watson et al.		
	C6	4,069,345	01/17/1978	Gascoyne et al.		
	C7	4,070,496	01/24/1978	Rowsell et al.		
	C8	4,112,066	09/05/1978	Hussein		
	C9	4,136,164	01/23/1979	Rowsell et al.		
	C10	4,137,304	01/30/1979	Rowsell et al.		
	C11	4,137,305	01/30/1979	Rowsell et al.		
	C12	4,150,052	04/17/1979	Watson et al.		
	C13	4,178,459	12/11/1979	Watson et al.		
	C14	4,193,936	03/18/1980	Watson et al.		
	C15	4,226,988	10/07/1980	Watson et al.		
	C16	5,169,658	12/08/1992	Yalka et al.		
	C17	5,236,719	08/17/1993	Meyers et al.		
	C18	5,244,760	09/14/1993	Upson et al.		
	C19	5,458,892	10/17/1995	Yalka et al.		
	C20	5,543,160	08/06/1996	Song et al.		
	C21	5,545,416	08/13/1996	Song et al.		
	C22	5,612,071	03/18/1997	Song et al.		
	C23	5,614,234	03/25/1997	Song et al.		
	C24	5,698,181	12/16/1997	Lou		
	C25	5,800,847	09/01/1998	Song et al.		
	C26	5,976,581	11/02/1999	Song et al.		
	C27	6,030,647	02/29/2000	Song et al.		
	C28	6,080,432	06/27/2000	Tyrpin et al.		
	C29	6,440,472 B1	08/27/2002	Song et al.		
	C30	6,455,080 B1	09/24/2002	Wolf et al.		
	C31	2003/0082271 A1	05/01/2003	Wolf et al.		
	C32	6,586,023 B1	07/01/2003	Song et al.		
	C33	6,602,518 B2	08/05/2003	Seielstad et al.		
	C34	6,613,346 B2	09/02/2003	Seielstad et al.		

EXAMINER	DATE CONSIDERED
----------	-----------------

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Rev. Dec.-99

C:\Documents and Settings\sp\Local Settings\Temporary Internet Files\OLK62\1391-1554 2nd Suppl. PTO Form 14491.doc

Page 2 of 2

FORM PTO-1449	SERIAL NO.	CASE NO. 1391/1554
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (use several sheets if necessary)	FILING DATE Sept. 30, 2003	GROUP ART UNIT 1761
APPLICANT(S): Fred R. Wolf		

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS/ SUBCLASS	TRANSLATION YES	NO
	C35	CA 989738	05/25/1976	Canada			
	C36	GB 1311060	03/21/1973	United Kingdom			
	C37	GB 2233873 A	01/23/1991	United Kingdom			
	C38	WO 93/23005	11/25/1993	WIPO			
	C39	WO 93/25177	12/23/1993	WIPO			
	C40	WO 94/08550	04/28/1994	WIPO			
	C41	WO 94/08551	04/28/1994	WIPO			
	C42	WO 94/21135	09/29/1994	WIPO			
	C43	WO 94/25003	11/10/1994	WIPO			
	C44	WO 94/25009	11/10/1994	WIPO			
	C45	WO 99/13734	03/25/1999	WIPO			
	C46	WO 99/13870	03/25/1999	WIPO			

EXAMINER INITIAL	OTHER ART (Including Author, Title, Date, Pertinent Pages, etc.)	
	C47	Watson, Hugh R., "Flavor Characteristics of Synthetic Cooling Compounds", <i>Flavor: Its Chemical, Behavioral, and Commercial Aspects Proceedings of the Arthur D. Little, Inc. Flavor Symposium, 1997</i> , Published by Westview Press, Boulder CO, 1978, pp 31-50.
	C48	Watson, H. R. et al., "New compounds with the menthol cooling effect", <i>J. Soc. Cosmet. Chem.</i> , Vol. 29, 1978, pp. 185-200.

EXAMINER	DATE CONSIDERED
----------	-----------------

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Rev. Feb.-97

C:\Documents and Settings\ps\Local Settings\Temporary Internet Files\OLK62\1391-1554 2nd Suppl. PTO Form 14491.doc